

REMARKS

Summary of the Office Action

Claims 1 and 4 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,862,971 to *Ebner* hereinafter ("*Ebner*").

Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ebner* in view of U.S. Patent No. 5,836,502 to *Kanai, et al.*, hereinafter ("*Kanai*").

Claims 2-3 stand objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Summary of the Response to the Office Action

Applicants have amended claims 1, 2, 4, and 5 and rewritten claim 2 in independent form as suggested by the Examiner. Claim 6 is withdrawn. Accordingly, claims 1-5 are presently pending.

The Rejection under 35 U.S.C. § 102(b)

Claims 1 and 4 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Ebner*. Applicants respectfully traverse the rejection for the following reasons.

Applicants respectfully submit that the Office Action has not established that *Ebner* anticipates each and every feature of Applicants' claimed invention and that all rejections under 35 U.S.C. § 102(b) should be withdrawn. Newly amended independent claims 1 and 4 recite, in part, "a table, supported by a main body frame of the electric stapler, and including a clincher mechanism for folding to bend a leg portion of the staple penetrated through the sheets along the

sheets, and a wing piece formed on each side of the table.” *Ebner* fails to teach or suggest at least these features of independent claims 1 and 4.

In the present invention, there is a wing on each side of the table supported by the main body frame. However, *Ebner* discloses a slider (4) and an actuator (5) both disposed on one side of an electric stapler (1). Accordingly, *Ebner* fails to teach or suggest each and every feature of amended claims 1 and 4. Thus, the rejection of claims 1 and 4 should be withdrawn.

As pointed out in MPEP § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicants respectfully assert that the rejection under 35 U.S.C. § 102(b) should be withdrawn because *Ebner* does not teach or suggest each feature of independent claims 1 and 4.

The Rejection under 35 U.S.C. § 103(a)

Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ebner* in view of *Kanai*. Applicants respectfully traverse the rejection for the following reasons.

To establish a *prima facie* case of obviousness, three basic criteria must be met (see MPEP §§ 2142-2143). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references must teach or suggest all the claim limitations.

The Office Action has not established a *prima facie* case of obviousness at least because *Ebner* and *Kanai*, whether alone or in combination, fail to teach or suggest all the recited features

of newly amended independent claim 5. Independent claim 5 recites, in part, “engaging teeth in a sawtooth-like shape formed at the wing piece; and a locking piece formed with locking teeth engageable with the engaging teeth, wherein the locking piece is supported by the main body frame slidably in directions to engage and separate from the wing piece, wherein by engaging the locking teeth of the locking piece with the engaging teeth of the wing piece, the wing piece is hampered from being pivoted and the pivoting force in the opening direction of the table is hampered.” *Ebner* or *Kanai*, whether taken alone or in combination, fail to teach or suggest at least these features of claim 5.

Applicants note that the orientation of the alleged main body frame (1, base frame) and the alleged table (2, magazine) in *Kanai* are inverted because the recited table must have a clincher mechanism, and in *Kanai* the alleged main body frame (1) has the clincher mechanism. To fit in the alleged framework with *Ebner*, *Kanai* must work with it in at least one orientation. Claim 5 recites that “wherein the locking piece is supported by the main body frame slidably in directions to engage and separate from the wing piece.” If the alleged wing piece in *Kanai* is 11, (11, driving links) the alleged wing piece (11) supports the alleged locking piece (52, racket). However, the alleged locking piece (52) must be supported by the alleged main body frame (1) as required by claim 5. Thus, *Kanai* does not satisfy this orientation of components.

Should the Examiner later state that the orientation of *Kanai* should be inverted when it is combined with *Ebner*, that combination would not work either because the alleged main body frame (1, base frame) would become the alleged wing piece, and the alleged main body frame (1) does not have any “engaging teeth in a sawtooth-like shape formed at the wing piece,” as recited

in claim 5. As such, at least the features of claim 5 are neither disclosed nor taught, alone or in combination, by either *Ebner* or *Kanai*. Thus, the rejection of claim 5 should be withdrawn.

As pointed out in M.P.E.P. § 2143(A), one criteria used to establish *prima facie* obviousness of a claimed invention is that there must be a finding that the prior art included each element claimed. Because *Ebner* or *Kanai*, whether taken alone or in combination, fail to teach or suggest each feature of independent claim 5, the rejection under 35 U.S.C. § 103(a) should be withdrawn.

The Office Action also has not established a *prima facie* case of obviousness at least because there is no suggestion or motivation to combine *Ebner* and *Kanai*. To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill the art, to combine reference teachings. See M.P.E.P. §§ 2142-2143.

The Office Action acknowledges that *Ebner* does teach an “electric stapler with locking means” and alleges that it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the locking means of *Ebner* with the engaging teeth of *Kanai* in order to arrive at the present invention. See the Office Action, page 3, paragraph 2.

Applicants respectfully disagree.

As pointed out in MPEP § 2145(X)(D)(2), it is improper to combine references where the references teach away from their combination. As demonstrated above, the combination or references to not teach all the elements of claim 5. Thus, *Ebner* teaches away from its

combination with *Kanai*. Moreover, one of ordinary skill in the art to which the invention pertains would not have been motivated to combine *Ebner* and *Kanai*.

As such, the suggestion or motivation to combine is not provided by either the references themselves or by knowledge generally available to one of ordinary skill in the art. Thus, the rejection of claim 5 should be withdrawn.

“The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).” See MPEP § 2143.01. The Office Action does not provide any citation to the references of record that shows the desirability of combining *Ebner* and *Kanai*. Further, as discussed above, the combination of references necessarily includes features that teach away from the present invention. The mere assertion that *Ebner* and *Kanai* could be combined is not sufficient by itself to establish *prima facie* obviousness. Therefore, it is respectfully submitted that the Office Action has not met the second prong of *prima facie* obviousness. Accordingly, the rejection of claim 5 should be withdrawn.

The Objection to Claims 2-3

Claims 2-3 stand objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 2 was rewritten in independent form in accordance with the Examiner's suggestion. Therefore, claim 2 is an allowable form. Additionally, Applicants respectfully submit that dependent claim 3 is also allowable insofar as it recites the patentable

combinations of features recited in claim 2, as well as reciting additional features that further distinguish over the applied prior art.

CONCLUSION


In view of the foregoing, Applicants respectfully request reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.R.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

By:



David E. Connor
Reg. No. 59,868

Dated: February 28, 2008

CUSTOMER NO. 009629
MORGAN, LEWIS & BOCKIUS LLP
1111 Pennsylvania Avenue, N.W.
Washington, D.C. 20004
Tel: 202-739-3000
Fax: 202-739-3001